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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,330	04/07/2004	Gregg D. Scheller	54084-47038	8512
21888 7590 02/07/2008 THOMPSON COBURN, LLP ONE US BANK PLAZA SUITE 3500 ST LOUIS, MO 63101			EXAMINER DOWE, KATHERINE MARIE	
			ART UNIT 3734	PAPER NUMBER
			NOTIFICATION DATE 02/07/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKET@THOMPSONCOBURN.COM

Office Action Summary	Application No. 10/820,330	Applicant(s) SCHELLER ET AL. <i>CT</i>	
	Examiner KATHERINE M. DOWE	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/15/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The preliminary amendment filed 4/7/2004 is acknowledged.
2. Claims 25-52 are currently pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 25-27, 29-30, 36-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hart (US 5,584,845). Hart discloses a microsurgical instrument comprising first and second operative microsurgical surfaces (8/28), means for manually moving the operative surfaces toward and away from each other (Fig 1-2), and at least one operative surface having a series of serrations (col 3, ln 56) where each serration, which has the same width as the operative surface, has a width dimension ranging from 0.0015 of an inch to 0.0039 of an inch (col 5, ln 28-29). The operative surfaces may be considered forcep jaws when used to grasp tissue and scissor blades when used to sever tissue. The jaws are connected to an elongate rod (4).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 28 is rejected under 35 U.S.C. 102(b) as anticipated by Hart (US 5,584,845) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hart (US 5,584,845), as applied to claim 25 above. Hart discloses a microsurgical instrument comprising first and second operative microsurgical surfaces (8/28), means for manually moving the operative surfaces toward and away from each other (Fig 1-2), and at least one operative surface having a series of serrations (col 3, ln 56) where each serration, which has the same width as the operative surface, has a width dimension ranging from 0.0015 of an inch to 0.0039 of an inch (col 5, ln 28-29). Hart does not disclose the device is formed by wire electric discharge. However, the claimed phrase "being a wire electric discharge machined surface" is being treated as a product by process limitation; that is, the serrations are made by wire electric discharge machining. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made

and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113.

Thus, even though Hart does not disclose wire electric discharge machining is used to make the series of serrations, it appears that the product in Hart would be the same or similar as that claimed; especially since both applicant's product and the prior art product has a width dimension within the range of 0.0015 of an inch to 0.0039 of an inch.

8. Claims 31-35, and 38-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart (US 5,584,845), as applied to claims 30 and 37 above, in view of Toth et al. (US 6,616,683). Hart discloses the invention substantially as claimed including a microsurgical instrument comprising first and second operative microsurgical surfaces (8/28), means for manually moving the operative surfaces toward and away from each other (Fig 1-2), and at least one operative surface having a series of serrations (col 3, ln 56) where each serration, which has the same width as the operative surface, has a width dimension ranging from 0.0015 of an inch to 0.0039 of an inch (col 5, ln 28-29). The operative surfaces may be considered forcep jaws when used to grasp tissue and scissor blades when used to sever tissue. The jaws are connected to an elongate rod (4).

However, Hart does not disclose the forcep jaws and the rod are formed from a single piece of material. Toth et al. disclose a similar microsurgical instrument comprising first and second operative microsurgical surfaces (14-2) connected to a

distal end of an elongate rod (14-1) where the rod and operative surfaces are formed of the same material. Electric discharge machining is used to form a slot (14-3) in the rod to separate the operative surfaces as resilient spring arms (col 3, ln 5-16, 50-67; Figs 3A-3B). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Hart such that a single rod with a longitudinal slot was used to form the rod and jaw or blade portions of the device. Thus, the additional manufacturing steps of affixing jaw or blade portions to an elongate rod, or handle portion, would be eliminated. Additionally, the device will be structurally stronger as an integral material.

Regarding claims 48 and 52, Hart does not disclose the serrations are formed by wire electric discharge. However, the claimed phrase "having been formed solely by wire electric discharge machining" is being treated as a product by process limitation; that is, the serrations are made by wire electric discharge machining. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, even though Hart does not disclose wire electric discharge machining is used to make the series of serrations, it appears that the product in Hart would be the same or similar as that claimed; especially since both applicant's product and the prior art product has a width dimension within the range of 0.0015 of an inch to 0.0039 of an inch.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHERINE M. DOWE whose telephone number is (571)272-3201. The examiner can normally be reached on M-F 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Katherine Dowe
February 1, 2008



MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER